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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/729,341	10/16/1996	OPHIRA R. AHARONSON		3864

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RINES AND RINES
81 NORTH STATE STREET
CONCORD, NH 03301

EXAMINER

NGUYEN, CHANH DUY

ART UNIT	PAPER NUMBER
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2675

DATE MAILED: 11/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/729,341

Applicant(s)

AHARANSON ET AL

Examiner

Chanh Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 1996.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The amendment filed on October 16, 1996 has been entered and considered by examiner.

Drawings

2. The drawings are objected to because the problems address by Draftsperson (see attached PTO-948).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-16, 18-47 and 49-50 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 1 and 32 copied from Cotte's reference (U.S. Patent No. 5,499,108) recite "wherein said placement alone is sufficient to initiate said drawing, and said computer comprising means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data". However, there is no description in the specification to support the feature of the placement alone is sufficient to initiate said drawing nor means for displaying, in response to said

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placement, a plurality of user-selectable options for processing said image data. The closest disclosure in the specification is as follows:

(a) Figure 1 of the application shows a monitor (H2), but does not disclose the feature of " means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data".

(b) On page 18, lines 14-18 of the specification discloses a master mode which the scanner automatically starts scanning, but does not discloses the limitations "means for displaying, in response to said replacement, a plurality of user-selectable options for processing said image data".

(c) On page 22, last line to page 23, line 2, discloses that "the user may choose to use a scanner for data input by picking operation from a menu or typing a specification", but does not disclose the feature " means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data". For example, the specification does not disclose a menu displayed on the screen. The menu mentioned in the specification may be placed on the keyboard before replacement. Even the menu of the specification is displayed on the monitor, but the specification does not disclose the limitation "means for displaying, in response replacement..."

No where in the specification discloses the limitation "means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data".

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Dependent claims 18-19 and 49-50 recite the limitations ""scanning means sends an interrupt to said computer in response to said replacement" and ""said image data periodically polls said input device". However, nowhere in the specification discloses such limitation above. Page 18, lines 14-18 of the specification describes a master mode with the host receives the scanned data into "spool" directory where it is stored for application to retrieve it, but does not mention the limitations "interrupt" nor "periodically polls" as recited in the claims.

In dependent claims 12 and 43 similar problems as previously discussed with respect to claim 1 above. That is no where in the specification discloses the limitation "means for displaying a visual presentation of image data generated in response to said placement".

In dependent claims 20 and 26 recite the limitation " a plurality of user selectable options for processing said image data wherein said placement alone is sufficient to initiate display of said options". Again, nowhere in the specification discloses this limitation for the same reason as addressed in claim 1.

The remaining claims 2-11, 13-16, 21-25, 27-31, 33-42, 44-47 are rejected to as being dependent upon a rejected base claims.

In view of lacking written description, no art rejection has been applied since the specification does not support the limitations recited in the claims 1-16, 18-47 and 49-50.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 17 and 48 and 55-56 are rejected under 35 U.S.C. 102(e) as being anticipated by Kamada et al (U.S. Patent No. 5,099,340).

As to claim 17, Kamada discloses a document -driven scanning input device communicating with a computer including a scanning means (5) for generating image data representing the image of a document, means (e.g., determining device 14) for drawing the document into scanning relationship with scanning means (5) in response to placement of document by a user so that the scanning means generates image data representing the image document; see column 6, through page 7, line 2. Kamada clearly teaches the placement alone being sufficient to initiate the drawing. That is scanner 5 automatically scans the document by an automatic paper feeding (5a), determining device (14) and recognizing device (29). Kamada teaches that " the

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storage device 6 for causing storage device 6 to store the image signal of the document base on the information recognized by recognizing device 29" (see column 6, lines 65-68) as well as "facsimile transceiver circuit 10 temporarily stores the received image signal in memory 9 (see column 5, lines 57-68). This reads on the claimed "said computer comprising means for storing said image data generated in response to said replacement".

As to claims 48 and 55-56, these claims recite the limitation similar to claim 17. That is automatically start to scan upon replacement of a document in the scanner. Thus, it is analyzed as previously discussed with respect to claim 17 above.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 51-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamada in view of Hongoh (U.S. Patent No. 5,115,3740) or Kotani et al (U.S. Patent No. 5,265,152) .

As to claim 53, note the discussion of claim 55 above, this claim differs from claim 55 only in that the limitation " a guide in the scanner for receiving a document to be scanned" is additionally recited. Using a guide in the scanner is well-known in the art. For example, Hongoh teaches paper guide roller (17, 20) ;see column 3,lines 58-60. Kotani teaches a pair of guides (16) for guiding original sheets to an inside the facsimile (see column 3,lines 31-33). Therefore, it would have been obvious to one of ordinary skill in the art at the invention was made to have added the guide as taught by Hongoh or Katani to the facsimile of Kamada so as to avoid paper jam.

As to claim 51, this claim differs from claim 53 only in that the limitation 'slave mode" is additionally recited. This limitation reads on the operator inputting the information through a keyboard 2 in response to the incomplete information as taught by Kamada (see column 7, lines 38-39).

As to claims 52 and 54, Hongoh clearly teaches internal fax modem (21); see column 3, lines 64-65.

Inquiries

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chanh Nguyen whose telephone number is (703) 308-6603.

If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, Steven Saras can be reached at 305-9720.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:


(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121
Crystal Drive, Arlington, VA, Sixth Floor (Receptionist)

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.



C. Nguyen
October 31, 2002



CHANH NGUYEN
PRIMARY EXAMINER